REMARKS

Presently, claims 1-10, 12-18, 60 and 62-93 are pending in the application. A Request for Continued Examination under 37 C.F.R. §1.114 is being filed herewith. Independent claims 1 and 60 have been amended to more clearly define and particularly point out the present invention and to overcome the Examiner's objections to claim 1. Support for the amendments to independent claims 1 and 60 may be found, for example, at page 13, line 20 – page 14, line 15 of the specification. Dependent claims 2, 6, 62, 64 and 70-72 have been amended to be consistent with independent claims 1 and 60 as amended. Claim 61 has been canceled. New dependent claims 73-78 have been added to further define the present invention. Support for the features of claims 73-78 may be found, for example, at page 13, line 20 – page 14, line 15 of the specification. New independent claim 79 has been added to alternatively recite the present invention. Support for the features of new independent claim 79 may be found, for example, in independent claims 1 and 60 and at the paragraph bridging pages 11-12 of the specification. New dependent claims 80-93 have been added to depend from new independent claim 79 and correspond to dependent claims 62-72 and 76-78, respectively. Accordingly, no new matter has been added to the application by the foregoing amendments.

Claim Objections

The Examiner has objected to claim 1 for improperly including claim language that was changed with respect to the previous listing of the claims. Specifically, in the previous Amendment of March 2, 2005, in line 12 of claim 1, the element "one or more intervals" was changed to --intervals--. This change to claim 1 was not indicated in the March 2, 2005, Amendment with respect to the previous set of pending claims.

Applicants thank the Examiner for pointing out this informality. Since such a change was never intended to claim 1, in the present Amendment Applicants have listed claim 1 with the original language of "one or more intervals" (now line 14) and have not

made any changes to such language. Since no changes to this portion of claim 1 were entered in the March 2 Amendment, the present listing of claim 1 does not indicate any changes to this portion of claim 1. Applicants note that other portions of claim 1, as well as independent claim 60 and claims dependent thereon, have been amended to incorporate the "one or more intervals" language, such that these claims are consistent with independent claim 1. Reconsideration and withdrawal of the Examiner's objection to claim 1 are respectfully requested.

Prior Art Rejections – § 103(a)

The Examiner has rejected claims 1, 2, 7, 8, 10, 12-18 and 60-72 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond *et al.* ("Zigmond") in view of U.S. Patent Publication No. 2003/0200128 A1 Doherty ("Doherty"). The Examiner contends that Zigmond teaches all features of the claimed invention with the exception of a queue having an ordered list of advertisement resource locators ("ARLs") and retrieving an ARL from the queue in accordance with the ordered list. The Examiner further contends that Doherty teaches these features, and concludes that it would have been obvious to modify Zigmond's system to include a queue having an ordered list as taught by Doherty, resulting in Applicants' claimed invention. In view of the foregoing amendments, Applicants respectfully traverse this rejection.

Zigmond teaches a system and method for selecting and inserting advertisements into a video programming feed, and is particularly directed to where and how ad selection is accomplished. In Zigmond, ads are delivered to the viewer by being multiplexed with the programming feed, transmitted over another, separate network, or periodically downloaded to the insertion device. "Household data", including viewer, system and/or demographic information, characterizes the viewer, and is referenced to determine which ads should be selected and inserted into the programming feed. The programming feed is interrupted by an "ad insertion device" that inserts the selected ad. Zigmond's system has the ability to select ads on demand.

Doherty teaches a method of scheduling "items of information" (including advertisements) intended for display to localized audiences (e.g., in public transport or waiting areas). In Doherty, each item is assigned a priority according to when it would be most useful to be displayed. The items of information are then scheduled for presentation to the viewer based on their priority. The most suitable ads are determined by calculating priority as a function of time under the "current conditions", such as location, user profile, time remaining for display, etc. Doherty includes a user activity analyzer that monitors user interaction and develops a user profile to assist the scheduler. The priority determination is made "on the run" to react to unpredictable user interaction. The current schedule of items is cleared, for example, when user interaction is detected or other triggering events (such as the beginning of the display period) occur.

Independent claim 1, as amended, recites:

> A method of selectively inserting advertisements into a programming stream at different receiving nodes of a communications network, said method comprising:
>
> (a) transmitting the programming stream from a central location to one or more receiving nodes;
>
> (b) storing advertisements at a node of said network, each advertisement being previously matched to one or more subscribers associated with one of said receiving nodes;
>
> (c) storing one or more queues, each of said queues corresponding to a subset of said receiving nodes, said queues comprising an ordered list of advertisement resource locators (ARLs), each of said ARLs comprising data disclosing a location of a corresponding advertisement;
>
> (d) selling locations in said queues;
>
> (e) determining, at each of said receiving nodes, one or more intervals in said programming stream within which advertisements may be inserted;
>
> (f) responsive to said determination, retrieving from said queue corresponding to said receiving node one of said ARLs in accordance with said ordered list, wherein the order of the ARLs in

said ordered list is independent of the timing of the determined one or more intervals; and

(g) inserting said advertisement corresponding to said retrieved ARL into said programming stream at said receiving node within said determined one or more intervals.

Zigmond does not teach or suggest a method that includes "storing advertisements" that have been "previously matched to one or more subscribers associated with one of said receiving nodes." Initially, Applicants point out that Zigmond's system does not use or insert advertisements that are matched to a particular subscriber prior to being stored in a queue. That is, in Zigmond, the ads that are being inserted into the program stream must be positively "selected" *after* they have been downloaded. Thus, in Zigmond, even though an advertisement is resident at a subscriber location (e.g., a set top box), that advertisement is not necessarily matched or presented to the subscriber unless it is subsequently, positively selected for display to that subscriber. Such a selection is made in response to a determination as to whether that advertisement should be inserted into the relevant program stream, and is independent of the fact that a particular advertisement has been downloaded. However, in Applicants' invention of claim 1, since the advertisements have already been matched to the subscriber upon storing the matched advertisements and placing them in the queue, there is no need to "select" the advertisement(s) or ARL(s) for display. Rather, the next advertisement or ARL in the queue is the ad that is inserted.

Zigmond does also not teach or suggest that the order of the ARLs or advertisements in the order list of the queue is "independent of the timing of the determined one or more intervals." Zigmond's system selects and inserts ads that are associated with the timing of a particular advertisement space, time slot and/or program content. Stated differently, in Zigmond, the particular advertisement that is selected for display is chosen with respect to the particular avail or interval into which it will be inserted. Therefore, the selected advertisement in Zigmond is a time-related selection. In contrast, the present invention retrieves ARLs or advertisements in accordance with the ordered list of the queue. The order of the ARLs or advertisements in the ordered list is independent of the timing of the avail or determined interval into which the

corresponding advertisement is inserted. Therefore, in Applicants' invention the particular time at which the determined interval actually occurs is irrelevant since the ARL or advertisement is taken from the queue without regard for the timing of that interval. Furthermore, as the Examiner acknowledges, Zigmond does not teach or suggest a queue that includes an ordered list of ARLs or advertisements to be displayed to the subscriber. Rather, Zigmond teaches simply selecting an advertisement from several available ads. Moreover, since Zigmond does not teach or suggest a queue effectively holding an order for ads to be displayed, Zigmond certainly does not teach the concept of selling locations within that queue. Accordingly, Zigmond does not teach or suggest all of the features recited in independent claim 1.

Doherty also does not teach or suggest storing advertisements that have been "previously matched to one or more subscribers." Doherty does not even discuss the downloading and/or storage of advertisements, let alone storing ads that have been previously matched to a particular subscriber or viewer. Rather, in Doherty, the advertisements are displayed to a potentially large and/or diverse group of viewers (i.e., in a public transportation setting). Thus, it would not make sense in Doherty to match ads to particular subscribers upon storage of those advertisements. As such, Doherty does not teach a queue that includes previously matched advertisements. Doherty also does not teach or suggest an ordered list where the order of the ARLs or advertisements in the list is independent of the timing of the interval into which the corresponding advertisement is inserted. That is, Doherty creates an ad schedule which is used for immediate presentation of the ads as determined by the schedule. The ad schedule is based on the assigned priority of each ad under the current conditions. The priority of the ads (and thus the ad schedule) are determined as a function of time (see, for example, paragraphs [0007] and [0025] of Doherty). Accordingly, Doherty's system generates a definite time-based schedule of which and when ads are to be inserted. However, as discussed above, the present invention retrieves ARLs or advertisements based on an order that is "independent of the timing of the determined one or more intervals."

Furthermore, assuming *arguendo*, that Doherty's system teaches determining an "order" or "queue" for the insertion of advertisements, Doherty does not teach or suggest selling locations within that queue. In traditional ad display schemes (such as Doherty),

it is the particular ad space that is sold to advertisers. In the present invention, the locations within the queue are sold. Accordingly, Doherty does not teach or suggest the features recited in independent claim 1.

Not only do Zigmond and Doherty not individually teach the present invention, but, even if these references are taken in combination as contended by the Examiner, such a combination fails to teach or suggest all of the features of claim 1. More specifically, neither of the applied references teaches or suggests storing advertisements that have been previously matched to a subscriber and storing those previously matched ads (or corresponding ARLs) in a queue for insertion into a programming stream. Additionally, neither of the applied references teaches an ordered list of ARLs in a queue, where the order of the ARLs in the list is independent of the timing of the determined interval. As such, the combination of Zigmond and Doherty is also lacking these features. Accordingly, independent claim 1 is believed to be allowable over the combination of Zigmond and Doherty.

Independent claim 60 recites the steps of "storing one or more queues...comprising an ordered list of advertisements, each advertisement being previously matched to one or more of the subscribers; selling locations in the queues;...and inserting advertisements from the queues into said programming stream...wherein the order of the advertisements in said ordered list is independent of the timing of the detected interval." For the same reasons discussed above with respect to independent claim 1, Zigmond and Doherty do not teach or suggest all of the elements of independent claim 60. Accordingly, independent claim 60 is believed to be allowable over Zigmond and Doherty, both individually and in combination.

New independent claim 79 recites the steps of "storing one or more queues...comprising an ordered list of advertisements, each advertisement being previously matched to one or more of the subscribers; selling locations in the queues;...and inserting advertisements from the queues into said programming stream...wherein the order of the advertisements in said ordered list is independent of the timing of the detected interval." For the same reasons discussed above with respect to independent claims 1 and 60, Zigmond and Doherty do not teach or suggest these

timing of the detected interval." For the same reasons discussed above with respect to independent claims 1 and 60, Zigmond and Doherty do not teach or suggest these elements of new independent claim 79. Additionally, independent claim 79 recites the steps of "(b) storing said programming stream at the one or more receiving nodes;...and (e) retrieving the stored programming stream from the one or more receiving nodes to create a retrieved programming stream." The method of claim 79 then inserts the appropriate advertisement from the queue into the retrieved programming stream. Neither Zigmond nor Doherty teach or suggest storing a programming stream and subsequently inserting an advertisement from a queue into the stream once it has been retrieved. Accordingly, independent claim 79 is believed to be allowable over Zigmond and Doherty, both individually and in combination.

Dependent claims 2, 7, 8, 10, 12-18, 62-78 and 80-93 are allowable at least by their dependency on independent claims 1, 60 and 79, respectively. Claim 61 has been canceled. Reconsideration and withdrawal of the Examiner's section 103(a) rejection of claims 1, 2, 7, 8, 10, 12-18 and 60-72 over Zigmond in view of Doherty are respectfully requested.

The Examiner has rejected claims 3-6 and 9 as being unpatentable over Zigmond in view of Doherty, and further in view of U. S. Patent No. 6,505,169 to Bhagavath *et al.* ("Bhagavath"). As discussed above with respect to the Examiner's obviousness rejection over Zigmond in view of Doherty, independent claim 1 is believed to be allowable over the combination of Zigmond and Doherty. Applicants respectfully submit that Bhagavath does not teach or suggest any of the elements missing from such combination. Thus, independent claim 1 is believed to be allowable over the combination of Zigmond, Doherty and Bhagavath. Accordingly, claims 3-6 and 9 are allowable at least by their dependency on independent claim 1. Reconsideration and withdrawal of the Examiner's section 103(a) rejection of claims 3-6 and 9 over Zigmond, Doherty and Bhagavath are respectfully requested.

The Examiner has rejected claims 1, 2, 7, 8, 10, 12-18 and 60-72 as being unpatentable over Zigmond in view of U.S. Patent No. 6,119,098 to Guyot *et al.* ("Guyot"). As with the previous rejection, the Examiner contends that Zigmond teaches

all features of the claimed invention, with the exception of a queue having an ordered list of targeted advertisements. The Examiner further contends that Guyot teaches such a queue, and that it would have been obvious to combine the teachings of Guyot with those of Zigmond to result in Applicants' claimed invention. Applicants respectfully traverse this rejection.

Guyot teaches a system and method of displaying targeted advertisements over a distributed network, such as the Internet. In Guyot, a queue of targeted advertisements is downloaded from a server to a client application on a user's computer. The advertisements that are in the queue are based on the user's personal profile. Once the advertisements have been downloaded, the client application continuously displays the advertisements on the user's computer (even if other applications are running on the user's computer) in accordance with the distribution requirements (or restrictions) of the queue. Guyot further teaches that the user's computer may monitor user interactions with the system to determine whether the schedule of ads in the queue should be altered. For example, if a user has not interacted with the system for some given period of time, the client application will enter a "screen saver" mode and therefore display different ads than if not in a screen saver mode. When the advertisement queue reaches a low level of available ads (i.e., because some ads have expired or been displayed the requisite number or amount of times), the client application accesses the server to obtain another queue of advertisements for display.

For the same reasons discussed above with respect to the Examiner's obviousness rejection over Zigmond in view of Doherty, Zigmond does not teach or suggest all elements of independent claims 1, 60 and 79.

Guyot also does not teach or suggest all features of Applicants' invention. In particular, Guyot does not teach or suggest a system or method having ARLs or advertisements that are retrieved from a queue, "wherein the order of the ARLs in the ordered list is independent of the timing of the determined one or more intervals." Initially, Applicants point out that the targeted advertisements in Guyot are not inserted into any type of program stream. Rather, in Guyot, the advertisements are continuously displayed to a user via a dedicated client application. As such, in Guyot there are no

intervals or avails to detect and insert advertisements into. Thus, although Guyot teaches a queue of targeted ads that specifies (to some degree) the order in which those ads are displayed to the user, there is no teaching in Guyot that the order of ARLs or advertisements in such a queue (i.e., ordered list) is independent of the timing of a determined interval. Accordingly, Guyot does not teach or suggest all of the features recited in independent claim 1.

Not only do Zigmond and Guyot not individually teach the present invention, but, even if these references are taken in combination as contended by the Examiner, such a combination fails to teach or suggest all of the features of claim 1. More specifically, neither of the applied references teaches or suggests retrieving an ARL from an ordered list of ARLs in a queue, where the order of the ARLs in the ordered list is independent of the timing of the determined interval. Since neither of the applied references teaches this feature, the combination of Zigmond and Guyot is also lacking at least this feature. Accordingly, independent claim 1 is believed to be allowable over the combination of Zigmond and Guyot.

Independent claim 60 recites the steps of "storing one or more queues...comprising an ordered list of advertisements, each advertisement being previously matched to one or more of the subscribers; selling locations in the queues;...and inserting advertisements from the queues into said stream...wherein the order of the advertisements in the ordered list is independent of the timing of the detected interval." For the same reasons discussed above with respect to independent claim 1, Zigmond and Guyot do not teach or suggest all of the elements of independent claim 60. Accordingly, independent claim 60 is believed to be allowable over Zigmond and Guyot, both individually and in combination.

New independent claim 79 recites the steps of "storing one or more queues...comprising an ordered list of advertisements, each advertisement being previously matched to one or more of the subscribers; selling locations in the queues;...and inserting advertisements from the queues into said programming stream...wherein the order of the advertisements in said ordered list is independent of the timing of the detected interval." For the same reasons discussed above with respect to

independent claims 1 and 60, Zigmond and Guyot do not teach or suggest these elements of new independent claim 79. Additionally, independent claim 79 recites the steps of "(b) storing said programming stream at the one or more receiving nodes;...and (e) retrieving the stored programming stream from the one or more receiving nodes to create a retrieved programming stream." The method of claim 79 then inserts the appropriate advertisement from the queue into the retrieved programming stream. Neither Zigmond nor Guyot teach or suggest storing a programming stream and subsequently inserting an advertisement from a queue into the stream once it has been retrieved. Accordingly, independent claim 79 is believed to be allowable over Zigmond and Guyot, both individually and in combination.

Dependent claims 2, 7, 8, 10, 12-18, 62-78 and 80-93 are allowable at least by their dependency on independent claims 1, 60 and 79, respectively. Claim 61 has been canceled. Reconsideration and withdrawal of the Examiner's section 103(a) rejection of claims 1, 2, 7, 8, 10, 12-18 and 60-72 over Zigmond in view of Guyot are respectfully requested.

The Examiner has rejected claims 3-6 and 9 as being unpatentable over Zigmond in view of Guyot, and further in view of Bhagavath. As discussed above with respect to the Examiner's obviousness rejection over Zigmond in view of Guyot, independent claim 1 is believed to be allowable over the combination of Zigmond and Guyot. Applicants respectfully submit that Bhagavath does not teach or suggest any of the elements missing from such combination. Thus, independent claim 1 is believed to be allowable over the combination of Zigmond, Guyot and Bhagavath. Accordingly, claims 3-6 and 9 are allowable at least by their dependency on independent claim 1. Reconsideration and withdrawal of the Examiner's section 103(a) rejection of claims 3-6 and 9 over Zigmond, Guyot and Bhagavath are respectfully requested.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that the Examiner's objection and rejections have been overcome, and that the application, including claims 1-10, 12-18, 60 and 62-93, is in condition for allowance. Reconsideration and withdrawal of the Examiner's objection and rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: Aug 22, 2005 By: Charles A Eldering

Charles A. Eldering
Registration No. 39,180
Technology, Patents, & Licensing, Inc.
6206 Kellers Church Road
Pipersville, PA 18947
Telephone: 215-766-2100
Facsimile: 215-766-2920